

## **REMARKS / ARGUMENTS**

### **Status of Claims**

Claims 1-19 and 35 are pending in the application. Claims 1-19 and 35 stand rejected. Applicant has amended claims 1-10, 12-19 and 35. Claim 11 has been cancelled. Accordingly, claims 1-10, 12-19 and 35 are presented and at issue. Applicant respectfully submits that the rejections under 35 U.S.C. §112, second paragraph and 35 U.S.C. §103(a), have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

### **Restriction Requirement**

The Examiner indicated that the restriction requirement will be upheld. Consequently, the elected claims are the species 1 group, claims 1-19 and 35.

### **Claim Objections**

The Examiner objected to claim 1 because lines 36-37 reciting “first and second desired destinations” is inconsistent with line 17 of claim 1 reciting “destinations”. Claim 1 has been rewritten to overcome this objection. The phrase “first and second desired destinations” has been removed from claim 1.

### **Rejections Under 35 U.S.C. §112, Second Paragraph**

Claims 1-19, and 35 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. More particularly, the Examiner alleged that the feature “having a storage subsystem” in line 2 of claim 1 is ambiguous because it is not clear which part of the claimed system includes this feature. Additionally, the Examiner alleged that the claimed feature “having a route planning subsystem “ in line 4 of claim 1 is ambiguous because it is not clear which part of the claimed system includes this

feature. Also, when lines 16-17, 20-23 and 33-34 of claim 1 are considered together, it appears that a destination selected by a user may be loaded more than once.

With respect to claim 2, the Examiner indicated that the phrases “a storage subsystem”, “a first memory”, “a second memory”, “a third program component”, and “first and second desired destinations” are ambiguous. The Examiner indicated that the phrase “the claimed storage subsystem” in claim 3 is ambiguous, as are the phrases “the agenda table” of claim 8, the “first memory” of claims 9, 13, and 16, the “first storage subsystem” of claim 16, and the “second computer system” of claim 17. Claim 35 was rejected for the reason explained above in connection with claim 9. The dependent claims were rejected on the basis of depending from a rejected base claim.

In view of the Examiner’s 35 USC 112 rejections, claims 1-10, 12-19 and 35 have been rewritten to provide proper antecedent basis for all elements recited in the claims, and to fully address the ambiguities noted by the Examiner. Accordingly, Applicants respectfully submit that the claimed subject matter is described in such a manner that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Accordingly, Applicants respectfully requests the Examiner to reconsider and withdraw this rejection, which Applicants consider to be traversed.

#### **Rejections Under 35 U.S.C. §103(a)**

Claims 1-19, and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Knockeart et al (US 6,622,083).

Applicants traverse these rejections for the following reasons.

Applicants respectfully submit that the obviousness rejection based on Knockeart is improper as Knockeart fails to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Independent claims 1, 9, and 35 have been amended to recite, *inter alia*, the portable agenda replication device instructing the vehicle navigation system to use the agenda to determine a route to follow to the destination based upon the requested time of arrival. For example, if a user requests a time of arrival that allows plenty of time to reach a destination, the determined route could include scenic features on less traveled routes. On the other hand, by way of illustration, if the time of arrival barely permits sufficient travel time for one to arrive at their destination, the determined route may include interstate highways and toll roads. Support for this claimed feature is found throughout Applicants' specification, for example in FIGs. 1 and 3 and paragraphs [0019], [0036]-[0041], and [0066]-[0070]. No new matter has been added. Moreover, the amended claims still read on the elected species (species 1), directed to transferring information from a remote computer to a vehicle navigation system.

Knockeart discloses techniques for using a removable device, such as a PDA, in conjunction with a driver information system. The removable device is brought to a vehicle and data in the removable device is transferred to the vehicle. However, Knockeart fails to teach or suggest the removable device providing instructions to the vehicle. Moreover, Knockeart fails to teach or suggest a portable agenda replication device instructing a vehicle navigation system to use an agenda to determine a route to follow to the destination based upon a requested time of arrival as set forth in Applicants' claims 1, 9, and 35.

In view of the foregoing considerations, it is submitted that claims 1, 9, and 35 are patentable over Knockeart. Dependent claims inherit all of the limitations of the respective parent claim and any intervening claim. Claims 2-8 inherit all of the limitations of claim 1. Similarly, claims 10 and 12-19 inherit all of the limitations of claim 9. Accordingly, it is submitted that claims 2-8, 10 and 12-19 are patentable over Knockeart for the reasons set forth above in connection with claims 1, 9, and 35.

In view of the foregoing, Applicants submit that Knockeart fails to teach or

suggest each and every element of the claimed invention and is therefore wholly inadequate in its teaching of the claimed invention as a whole. Knockeart fails to motivate one skilled in the art to do what the patent Applicants have done and includes no suggestion whatsoever that it would be desirable for its portable device to provide instructions to the vehicle. Additionally, Knockeart fails to recognize a problem recognized and solved only by the present invention, fail to offer any reasonable expectation of success to perform as the claimed invention performs, fail to teach a modification to prior art that does not render the prior art being modified unsatisfactory for its intended purpose, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §112, second paragraph and 35 U.S.C. §103(a), have been traversed, and respectfully requests that the Examiner reconsider and withdraw these rejections.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 09-0458. In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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